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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,647	07/17/2001	Ramachandran Murali	UPN-3963	3796

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EXAMINER

LY, CHEYNE D

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/720,647	Applicant(s) MURALI ET AL.	
	Examiner Cheyne D Ly	Art Unit 1631	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 7 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 14 January 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1 and 6-8.

Claim(s) withdrawn from consideration: 2-5 and 9-24.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Continuation of 2. NOTE:

Applicant's amendment to claim 1, and the addition of claims 25-27 raise new issues, therefore, said amendments have been denied entry because said new issues would require further consideration and/or search. The addition of steps a), b), and amendment to claims 1 and 26 introduce new issues would require further consideration and/or search. Further, claims 25 and 27 introduce new limitations that would require further consideration and/or search.

Claim 27 lacks any indication in the proposed amendment as being a new claim which raises the new issue of said claim being improperly amended due to lacking a status indication.

Specific to the new limitations of "identifying flexible site" and "about 15-20 Angstroms", said limitations are considered to be new matter because they have not been found in the pointed to support in the instant specification at page 12, line 26, to page 13, line 21, page 18, lines 5-14, page 7, line 25, and page 10, lines 15-31.

Upon the allowance of a generic claim 1 from which claim 9-24, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141.

CLAIM REJECTIONS - 35 USC § 102

Claims 1, 6, and 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Li et al. (1997).

This rejection is maintained with respect to claims 1, 6, and 7, as recited in the previous office action, mailed August 14, 2003. Applicant argues claim 1 has been amended to recite new limitations which help Applicant overcome the disclosure of Li et al. and secondary references for supporting documents such as Coffin et al. and Pieatier-Tonneau et al. Applicant's argument has been fully considered and found to unpersuasive due to the new limitations in the amended claim 1 raise issues that would require further consideration and/or search as discussed above.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 1 and 6-8 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of identifying a compound that modulates intermolecular interactions between a target protein, TNF, CD4 receptor, and β -lactamase, and a modifier, does not reasonably provide enablement for a method of identifying a compound that modulates intermolecular interactions between any target protein and a modifier. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

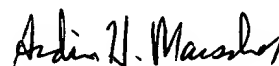
Claim 8 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling inhibitors of TNF receptor, CD4 receptor, and β -lactam, does not reasonably provide enablement for enhancers of TNF receptor, CD4 receptor, and β -lactam or any other receptors or substrates. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Applicant argues by asserting that "the test for enablement is not determined by whether the state of the art (at the time the application was filed) enable the claims, but involves a determination of whether the disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. Further, Applicant provides numerous patents to support said argument. Applicant's argument has been fully considered and found to be unpersuasive as discussed below.

Applicant is pointed to factors to be considered in determining whether a disclosure would require undue experimentation have been summarized in Ex parte Forman, 230 USPQ 546 (BPAI 1986) and reiterated by the Court of Appeals in In re Wands, 8 USPQ2d 1400 at 1404 (CAFC 1988) as cited in the previous Office Action, mailed August 14, 2003. Specifically factor (5) the state of the prior art, therefore, the instant application has been examined in regard to the state of the prior art at the time of the invention and the PTO has provide adequate support that the art of crystallization is unpredictable.

Applicant is advised that each application is examined based on its own fact pattern, therefore, the citation of issued patents does not help Applicant overcome the instant lack of enablement in scope rejection.

Specific to Applicants' argument and citation of the Protein Data Bank to argue that the state of the art is unpredictable due to the number having been crystallized. Applicant's argument has been fully consider and found to be unpersuasive as discussed in the previous office action, mailed August 14, 2003.


ARDIN H. MARSCHEL
PRIMARY EXAMINER